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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

MOORTHY, ARAVIND K

ART UNIT

PAPER NUMBER

2131

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/624,013

Applicant(s)

JESPERSEN ET AL.

Examiner

Aravind K Moorthy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-25 are pending in the application.
2. Claims 1-25 have been rejected.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 3. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claim 7, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). For the sake of examining, the examiner assumes that the pre-specified time is between 10 milliseconds and 5 minutes.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an

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international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-9, 12, 13, 18 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Rowney et al U.S. Patent No. 5,987,140.

As to claim 1, Rowney et al discloses a method for performing a transaction between a legal entity A that has an approval to perform such transaction and a legal entity B over a network [column 10, lines 4-19]. Rowney et al discloses the transaction being initiated by the legal entity A [column 10, lines 31-58]. Rowney et al discloses that the legal entity A, to verify the approval to the legal entity B, associates the transaction with a verification insignia (i.e. certificate) [column 11, lines 30-37]. Rowney et al discloses that the verification insignia is a unique transitory insignia provided to the legal entity A by a legal entity C who thereby guarantees that the legal entity A has the approval [column 15, lines 56-64]. Rowney et al discloses that the provision of the unique transitory insignia to the legal entity A by the legal entity C being conditioned by the legal entity A providing to the legal entity C a secret identification code (i.e. password) confirming the identity of the legal entity A to the legal entity C [column 12, lines 26-42]. Rowney et al discloses that the legal entity B validates the unique transitory insignia, and upon positive validation, and only then, accepts the transaction [column 15, lines 56-64]. Rowney et al discloses that the transitory unique insignia is invalidated substantially immediately after the validation [column 10, lines 31-58].

As to claim 2, Rowney et al discloses that the validation is guaranteed by the legal entity C [column 15, lines 56-64]. Rowney et al discloses that the legal entity C upon the guaranteeing invalidates the unique transitory insignia [column 10, lines 31-58].

As to claim 3, Rowney et al suggests that a first timestamp (i.e. issue date) is recorded by the legal entity C, the first timestamp comprising the date and time of the provision of the unique transitory insignia to the legal entity A by the legal entity C [column 11, lines 30-37]. The examiner asserts that it is well known in the art that a digital certificate contains the issue date.

As to claim 4, Rowney et al suggests that a second timestamp is recorded by the legal entity A [column 11, lines 30-37]. Rowney et al suggests that the second timestamp comprises the date and time when the legal entity A, to verify the approval to the legal entity B, associates the transaction with a verification insignia [column 18, lines 20-33].

As to claim 5, Rowney et al suggests that the unique transitory insignia comprises the first timestamp [column 11, lines 30-37].

As to claim 6, Rowney et al suggests that the transitory unique insignia is invalidated by the legal entity C substantially immediately after a pre-specified time counted from the time recorded in the timestamp (i.e. validity period) [column 11, lines 30-37]. The examiner asserts that it is well known in the art that a digital certificate contains a validity period that is counted down from the issue date.

As to claim 7, Rowney et al suggests that the pre-specified time is between 10 millisecond and 5 minutes [column 9, lines 24-32].

As to claim 8, Rowney et al discloses verifying of the correctness of the unique transitory insignia [column 15, lines 56-64].

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As to claim 9, Rowney et al discloses that the public network is the Internet [column 9, lines 51-61].

As to claim 12, Rowney et al discloses that the unique transitory insignia has a unique identification number [column 11, lines 30-37]. The examiner asserts that it is well known in the art that digital certificates contain a unique identification number.

As to claim 13, Rowney et al suggests that the unique identification number is associated with a financial agreement between the legal entity A and a trusted partner of the legal entity C [column 11, lines 30-37]. The examiner asserts that it is well known in the art that digital certificates contain a unique identification number.

As to claim 18, Rowney et al discloses that the legal entity C requests a payment by the legal entity B, the request being associated with the unique transitory insignia [column 17 line 37 to column 18 line 11].

As to claim 23, Rowney et al discloses that the unique transitory insignia (i.e. digital certificate) is comprised in a digital code [column 11, lines 30-37].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10, 24 and 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowney et al U.S. Patent No. 5,987,140 as applied to claim 1 above, and further in view of Puhl et al U.S. Patent No. 6,223,291 B1.

As to claim 10, Rowney et al does not teach that the network is adapted to use a wireless application protocol such as the WAP protocol.

Puhl et al teaches a network that is adapted to use a wireless application protocol such as the WAP protocol [column 2, lines 37-43].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Rowney et al so that the network was implemented using a wireless application protocol such as the WAP protocol.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Rowney et al by the teaching of Puhl et al because it allows clients to perform electronic commerce over a wireless network with enhanced security [column 1, lines 35-57].

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As to claims 24 and 25, Rowney et al does not teach that the digital code (i.e. certificate) is generated in a cellular phone, by means of a digital device provided by the legal entity C. Rowney et al does not teach that the digital code is encrypted.

Puhl et al teaches that the digital code (i.e. certificate) is generated in a cellular phone, by means of a digital device provided by the legal entity C. Puhl et al teaches that the digital code is encrypted.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Rowney et al so that the certificate was generated by a cellular phone provided by the third party. The certificates would have been encrypted during sessions.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Rowney et al by the teaching of Puhl et al because it allows clients to perform electronic commerce over a wireless network with enhanced security [column 1, lines 35-57].

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowney et al U.S. Patent No. 5,987,140 as applied to claim 1 above, and further in view of Aziz U.S. Patent No. 6,223,291 B1.

As to claim 11, Rowney et al teaches that the verification insignia is provided to the legal entity A by the legal entity C.

Rowney et al does not teach that it is transmitted over the Internet through a secure communication channel protected by the secret identification code.

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Aziz teaches a secure communication channel on the Internet protected by the secret identification code (i.e. password) [column 6, lines 4-18].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Rowney et al so that password would have been used to secure the communication channel on the Internet.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Rowney et al by the teaching of Aziz because it protects the connection from being taken over by an attacker [column 1, lines 31-38].

7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowney et al U.S. Patent No. 5,987,140 as applied to claim 1 above, and further in view of Haber et al U.S. Patent No. 5,136,646.

As to claim 22, Rowney et al does not teach that the unique identification number is selected from a pool of numbers agreed between the legal entity C and the trusted partners of the legal entity C. Rowney et al does not teach that the number is released after the transitory unique insignia has been invalidated.

Haber et al teaches that the unique identification number (i.e. transaction number) is selected from a pool of numbers agreed between the legal entity C and the trusted partners of the legal entity C [column 4, lines 56-67]. Haber et al teaches that the number is released after the transitory unique insignia has been invalidated [column 6, lines 33-41].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Rowney et al so that the unique identification on the certificate was the transaction number as taught by Haber et al. After the merchant

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authenticates the certificate and invalidates it, the receipt with the transaction number would have been released.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Rowney et al by the teaching of Haber et al because the receipt provides proof of the transaction [column 3, lines 10-27].

8. Claims 14, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowney et al U.S. Patent No. 5,987,140 as applied to claim 1 above, and further in view of Franklin et al U.S. Patent No. 5,883,810.

As to claims 14, 20 and 21, Rowney et al does not teach that the financial agreement comprises the trusted partner of the legal entity C providing the legal partner A with a payment card. Rowney et al does not teach that the unique number is selected in accordance with a unique number of the payment card. Rowney et al does not teach that the unique number is selected in accordance with a unique issuer identification number of the legal entity C or in accordance with a unique identification number of trusted partner(s) of the legal entity C.

Franklin et al teaches that the financial agreement comprises the trusted partner of the legal entity C providing the legal partner A with a payment card (i.e. credit card) [column 4, lines 36-47]. Franklin et al teaches that the unique number is selected in accordance with a unique number of the payment card (i.e. credit card number). Franklin et al teaches that the unique number is selected in accordance with a unique issuer identification number of the legal entity C or in accordance with a unique identification number of trusted partner(s) of the legal entity C [column 4, lines 48-65].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Rowney et al so that the issuing bank would have issued the credit card and the certificate. The certificate would have contained the credit card number.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Rowney et al by the teaching of Franklin et al because it substantially reduces the value of a stolen number since the number is only a proxy number for a single purchase. Stealing the proxy number would not greatly benefit a thief because it cannot be repeatedly used for other purchases or transactions. Another benefit is that the system integrates with existing card verification and settlement protocols. All parties, except the issuing bank, are able to treat the transaction number of the online commerce card in the same manner in which they process a Visa or MasterCard transaction today. No additional processing software is needed at the merchants or settlement participants [column 12, lines 10-20].

9. Claims 15-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowney et al U.S. Patent No. 5,987,140 as applied to claim 1 above, and further in view of Collin U.S. Patent No. 6,223,291 B1.

As to claims 15-17 and 19, Rowney et al does not teach that the unique identification number comprises at least a first and a second identification component. Rowney et al does not teach that the first identification component identifies the financial agreement and the second identification component identifies the legal entity C. Rowney et al does not teach that the second identification component is assigned to the legal entity C by a registration authority agreed between the legal entity C and a number of trusted partners of the legal entity C. Rowney

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et al does not teach there is interdependency between the financial agreement and a disbursement account. Rowney et al does not teach that the payment is withdrawn from the disbursement account.

Collin teaches that the unique identification number comprises at least a first and a second identification component. Collin teaches that the first identification component identifies the financial agreement (i.e. debit card number) [column 5, lines 4-11] and the second identification component (i.e. certificate issuer) identifies the legal entity C. Collin teaches that the second identification component is assigned to the legal entity C by a registration authority agreed between the legal entity C and a number of trusted partners of the legal entity C [column 10, lines 14-30]. Collin teaches there is interdependency between the financial agreement and a disbursement account (i.e. your debit account). Collin teaches that the payment is withdrawn from the disbursement account [column 11, lines 34-58].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Rowney et al so that the third party would assign a debit account with a user and a certificate. The certificate would contain the debit card account number as well as the certificate issuer. Every time the certificate was passed and used for a purchase, funds would be taken out of the corresponding debit account.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Rowney et al by the teaching of Collin because give a customer an opportunity to make purchases over the Internet and have funds withdrawn from their debit account securely.

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Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K Moorthy whose telephone number is 703-305-1373. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1373.

Aravind K Moorthy
January 15, 2004

Emmanuel L. Moise
EMMANUEL L. MOISE
PRIMARY EXAMINER
R/4 2136